

REMARKS

Initially Applicant thanks Examiner Edouard for discussing this application with Applicant and his attorney on January 14, 2003. During the telephonic interview, the cited prior art and the pending claims were discussed. Applicant noted that the pending claims recite the single step of forwarding the communication, the machine translation, and quotation to the recipient. The Examiner stated his opinion that the claims do not expressly exclude the separate steps of forwarding the communication and machine translation to the recipient, the recipient requesting a quote for a human translation, and thereafter forwarding the quotation to the recipient. Based upon this claim interpretation, the Examiner expressed his opinion that the claims read on the cited prior art. The claims have been amended to clarify that the step of generating a quotation for a human translation is an "automatic" step. In this way, the recipient does not need to separately request a quotation after receiving the communication or machine translation, and in this way the communication, the machine translation, AND the quotation may be forwarded to the recipient in one step.

In this Amendment, claims 1, 19, 20, 21, and 23 have been amended and new claims 24-28 have been added. Claims 1, 19, and 20 have been amended to clarify the step of "automatically" determining if a "quotation for" human translation of the communication is required. The claims have been amended to clarify the step of "automatically" applying a translation program. Support for these amendments is provided in the specification. Claim 21 has been amended to clarify that the automatic machine translation and automatic quotation are performed in response to "previously provided" instructions from the recipient. Support for this amendment is found in the specification at page 12, lines 5-7, which explain that certain user preferences "can be stored in a recipients preference file maintained on the mail server or the translation server." In addition, the specification at page 11, lines 14-15, discloses that the recipient may have "standard instructions" governing the need for a quotation for a human translation. Claims 24-28 recite that the communication, the machine translation, and the quotation are forwarded to the recipient "substantially simultaneously." These new claims are intended to preclude the Examiner's claim interpretation that the communication and a machine translation are forwarded to the recipient who then separately requests a quotation for a human translation and then the quotation is forwarded to the recipient.

The specification at page 12 discloses that the human translation quotation system may be "an automated system that calculates a quotation based on parameters such as the language,

number of words, urgency and complexity.” The specification at page 11, discloses that in most cases a quotation for human translation is determined, but in some cases, a recipient may not require a quote for a human translation. “A filter 15 checks for situations in which a quote for human translation is not required.” Similarly, the specification at page 10 discloses that if a foreign language communication is identified, “the filter 12 determines if translation is required. Some recipients may only require translation of some languages.... If translation is required a machine translation 14 is performed.” Moreover, the specification at page 4 states that the invention provides a method for “automatic processing of electronic communication.” In view of the following remarks, reconsideration and allowance of claims 1-16 and 18-23 are respectfully requested.

Claim Rejections - Rejection 35 USC § 103. The Office Action rejected claims 1-16 and 18-23 Section 103(a) as being unpatentable over Japanese Patent Application No. 10124516 (hereinafter, “JP516”) in view of U.S. Patent No. 5,608,622 to Church (hereinafter, “Church”) and Globalink. This rejection is respectfully traversed. None of these three citations make reference to either of the other two citations. Nor is there any suggestion in any citation that additional features beyond those described in the citation would be desirable. A teaching or motivation to combine references must be “clear and particular.” *In re Dembiczak*, 175 F.3d 994.

As stated in the background section of the present application, the invention delivers a system that offers flexibility and transparency in translating electronic documents. This object is achieved by following the multi-step method set out in claim 1 and 23, the system of claim 13, and using the computer network of claim 19. The steps are interrelated and co-dependent since a quotation for human translation is not generated unless a translation is required and the recipient desires the translation and the quotation. Furthermore, the communication, and if required the machine translation, and if required the quotation, are all sent to the recipient. No part of the invention operates in isolation. At no stage is a quotation for human translation generated and sent in the absence of the communication and the machine translation. The invention must be considered as a whole, and not as constituent parts.

JP516 discloses an automatic email translation system. JP516 teaches the identification of the language used by the sender of an email from the mail header and the language of the recipient from preferences set in their mail client. A translation of the text from the sender language to the recipient language is made for every communication. JP516 neither teaches nor

suggests that there is anything optional about the translation, nor that there could be any benefit it being optional. JP516 teaches total inflexibility. Moreover, JP516 fails to teach or suggest generating a quotation for a human translation or the desirability of quotation or providing a quotation for human translation along with the machine translation.

The MPEP requires the citations to be considered as a whole. It was error for the Examiner to focus on a small part of Church taken out of context. Church is directed to an unrelated field of technology. Church is not concerned with producing an electronic translation, as is JP516, but rather is directed to comparing a text with a translation. The essence of the Church invention is found at the bottom of column 4 in the section commencing "In overview" The section headed "Conclusion" in column 14 also highlights that Church is concerned with providing a translation assistant and not with electronically translating a communication from a sender prior to delivery to a recipient. The Church citation has been discussed in detail in the response to the previous Office Action.

There is no motivation to combine the teaching of JP516 with the teaching of Church because JP516 is concerned with electronically translating an email prior to delivery to a recipient and Church is directed to comparing a translation with the original text to assist a human translator.

Globalink is a single page press release that proposes that a price and time estimate is provided prior to translation being performed. The translation may range from a "fast and inexpensive machine translation" to a "more expensive, publication-quality work by professional translators." There is no teaching in the press release that a communication should be translated prior to delivery as taught by JP516. In fact, Globalink teaches away from JP516 because Globalink teaches that a price and time estimate is provided before any form of translation occurs. Nor does Globalink teach the need for a translation manager, such as that offered by Church. There is no motivation to combine Globalink with either JP516 or Church, and certainly no motivation to combine all three.

Even if there were motivation to combine all three citations, without the benefit of hindsight, they still do not teach a solution that provides a flexibility and transparency in translating electronic communications. There is no teaching, either individually or collectively, of forwarding the communication and, if required, the machine translation and, if required, the quotation to the recipient. "To establish *prima facie* obviousness of a claimed invention, all the

claim limitations must be taught or suggested by the prior art.” MPEP § 2143.03. In this case, all of the claim limitations are not taught or suggested by the prior art.

The claims are amended to clarify that the step of determining if a quotation for a human translation is required is an “automatic” step. It is not necessary for the recipient to separately request a quotation for human translation. None of the cited prior art references automatically prepares a quotation for a human translation.

For instance, JP516 discloses an automatic email translation system. It neither discloses nor suggests the steps of (1) determining if a quotation for a human translation of the communication is required and (2) applying a quotation program to the communication to generate a quotation for the human translation. The Church patent and the Globalink reference were cited for the purpose of disclosing human translation quotation systems: Both Church and Globalink provide a quotation only in response to a request or input by a customer, neither reference provides an automatic quotation. For example, Globalink discloses a system where customers identify a file to be translated, choose the source and desired languages, and select the level of service. Globalink then calculates a quotation for the level of service requested. Globalink does not automatically prepare a quotation, instead a separate request for a quotation must be made. Likewise, the Church patent states: “When the translation service bureau receives a job from a client, it enters information about the job in job details 142 and then analyzes the document to be translated and gives the customer a price.” Column 5, lines 2-5. Church does not automatically prepare a quotation, instead Church prepares a quotation only after details of the translation job are entered into the system. In view of the foregoing, neither, JP516, Church, nor Globalink, alone or in combination, automatically determines if a quotation for a human translation is required and automatically applies a quotation program to the communication to generate a quotation. Therefore, Applicant submits that the combination of JP516, Church, and Globalink fails to teach and suggest each and every claim limitation set forth in the claims.

In addition, the claims recite a step or apparatus for forwarding the communication, the machine translation, and the quotation to the recipient. None of the cited prior art references forward the communication, the machine translation, AND the quotation to the recipient. The JP516 reference discloses forwarding only the communication and machine translation. No quotation is disclosed or suggested by JP516. Globalink provides a quotation prior to any translation being performed. Therefore, Globalink does not teach or suggest forwarding the

communication and the machine translation in addition to the quotation. Finally, Church, like Globalink, discloses providing a quotation prior to any translation being performed. Therefore, Church does not teach or suggest forwarding the communication, the machine translation, and the quotation.

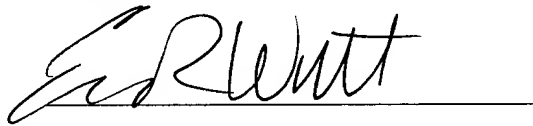
In view of the foregoing, neither, JP516, Church, nor Globalink, alone or in combination, teaches or suggests forwarding the communication, the machine translation, and the quotation to the recipient. This is especially true when considering claims 24-28. Therefore, Applicant submits that the combination of JP516, Church, and Globalink fails to teach and suggest each and every claim limitation set forth in the claims.

In view of the foregoing, Applicant submits that claims 1-16 and 18-28 would not have been obvious from the combined teachings of JP516, Church, and Globalink. Withdrawal of the rejection and allowance of the pending claims are respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. R. Witt", written over a horizontal line.

Evan R. Witt
Reg. No. 32,512
Attorney for Applicant

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MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 1, 19, 20, 21, and 23 have been amended as follows:

1. (Three times Amended) A method for automatic processing of electronic communication including the steps of:

- sending a communication from a sender in a first language;
- identifying the communication as a foreign language communication;
- determining if a translation of the communication to a second language is required by the recipient;
- applying a translation program to the communication to generate a machine translation if a translation of the communication to a second language is required by a recipient;
- automatically determining if a quotation for human translation of the communication to the second language is required by the recipient;
- automatically applying a quotation program to the communication to generate a quotation for the human translation if the human translation of the communication to the second language is required by the recipient; and
- forwarding the communication and, if required, the machine translation and, if required, the quotation to the recipient.

19. (Twice Amended) A computer in a networked computer environment, said computer programmed to perform the steps of:

- receiving a communication from a sender in a first language;
- identifying the communication as a foreign language communication;
- determining if a translation of the communication to a native language is required by the recipient;
- applying a translation program to the communication to generate a machine translation if a translation of the communication to a native language is required by a recipient;
- automatically determining if a quotation for human translation of the communication to the native language is required by the recipient;
- automatically applying a quotation program to the communication to generate a quotation for the human translation if the human translation of the communication to the native language is required by the recipient; and
- forwarding the communication and, if required, the machine translation and, if required, the quotation to the recipient.

20. (Twice Amended) The method of claim 1 further including the steps of:

- the recipient formulating a response to the communication;
- identifying the response as a native language response to the foreign language communication;
- determining if a machine translation of the native language response to generate a foreign language response is required by the sender;
- applying a machine translation program to the native language response to generate a foreign language response if required by the sender;
- automatically determining if a quotation for human translation of the native language response to generate a foreign language response is required by the sender;

if a human translation of the native language response to generate a foreign language response is required by the sender, automatically applying a quotation program to the native language response to generate a quotation for the human translation; and forwarding the foreign language response and, if required, the quotation, to the sender.

21. (Amended) A method for automatic processing of electronic communication including the steps of:

- sending a communication from a sender in a first language;
- identifying the communication as a foreign language communication;
- in response to one or more previously provided instructions by a recipient, automatically applying a translation program to the communication to generate a machine translation of the communication to a second language;
- in response to one or more previously provided instructions by a recipient, automatically applying a quotation program to the communication to generate a quotation for a human translation of the communication to the second language; and
- forwarding the communication and, if instructed, the machine translation and, if instructed, the quotation to the recipient.

23. (Amended) A method for automatic processing of electronic communication including the steps of:

- sending a communication from a sender in a first language;
- identifying the communication as a foreign language communication;
- automatically applying a translation program to the communication to generate a machine translation;
- automatically applying a quotation program to the communication to generate a quotation for a human translation; and
- forwarding the communication, the machine translation, and the quotation to a recipient.